

Question Q217

National Group: Malaysia

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

S15 of the Patents Act 1983 ("the Act") provides that:-

"An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraph 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art."

S14(2)(a) of the Act provides that :-

"prior art shall consist of a everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the pririty dateof the patent application claiming the invention."

Generally, inventive step denotes a quality of an invention that entails technical advances or improvement as compared to the existing knowledge. To meet the criterion, the patentee will have to show that such inventive step would not have been obvious to a person having ordinary skill in the art.

Obviousness is independent of anticipation. Where obviousness is in question, the area of investigation is not necessarily restricted to a single document and it may extend over an extensive field. Obviousness is relevant only to the issue of inventive

step. Even though the patented invention is not anticipated by prior disclosure, it is not patentable if it is obvious.

The Malaysian Courts have relied on the case of *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd* [1985] RPC 71 which laid down a four-structured approach to assessing non-obviousness, namely:

- (1) to identify the inventive concept embodied in the patent in suit;
- (2) then the court has to assume the mantle of a person having ordinary skill in the art (intepreted as the normally skilled but unimaginative addressee in the art) at the priority date and to impute to him what was, at that date, common general knowledge in the art in question;
- (3) thereafter to identify what, if any, differences exist between the matter cited as being "known or used" and the alleged invention; and
- (4) the court has to ask itself whether viewed without knowledge of the alleged invention, those differences constitute steps that would have been obvious to the skilled man or whether they require any degree of invention.

Indeed as obviousness is a question of fact, it must be decided objectively. On the issue of the skilled but unimaginative addressee, it is trite law that such a person is unimaginative and without even a scintilla of inventiveness.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

No, the standard itself has not changed since the Act came into force in 1986. This may be due to the fact that the provision in S 15 of the Act and the factual determination in reference to the prior art as at the date of priority is sufficiently flexible to take into account the development of technology.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

The Intellectual Property Corporation of Malaysia ("IPCM") publishes a guideline for patent examination which is useful to assist practitioners and applicants to the IPCM's practice on examination of the patent application.

The IPCM's Guidelines for Patent Examination is available at http://www.myipo.gov.my/files/PT_Guidelines.pdf. Chapter IV section 10 deals with inventive steps.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No. However, it must be noted that the burden of proving inventive step and non-obviousness is reverse during litigation. During prosecution of the patent application, the examiner must be satisfied and it is for the applicant to satisfy the examiner that the invention is non-obviousness. In litigation, the challenger has to show that the patent is obvious and does not fall within S15 of the Act and has to discharge this burden of proof.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

The construction of claims in Malaysia would be in reference to a person of ordinary skill in the art with intrinsic and extrinsic evidence and not to be read literally.

6. Is it possible to read embodiments from the body of the specification into the claims?

In construction of claims, the entire specification will be considered. However, it is not permissible to expand the claims by relying on a statement in the specification if the meaning of the claims is clear and unambiguous.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

For the interpretation of "prior art", it would be that the notional skilled person in the context of anticipation is a non inventive person in the sense that when considering the prior art, he is not inclined to carry out experiments with a view to find out something not already disclosed. Reliance on inherent disclosures is permitted.

8. Do the answers to any of the questions above differ during examination versus during litigation?

No..

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Lack of inventive step or obviousness may be found over a single prior art reference where the missing teaching(s) of that reference would have been obvious to a person of ordinary skill in the art at the time of the invention.

In the case of *Rhone-Poulenc Ag Company & Anor v. Dikloride Herbicides Sdn Bhd & Anor* [1987] 1 LNS 65 the Judge opined that to prove obviousness, the defendants have to produce evidence to satisfy the court that the invention claimed in each claim was one which was obvious to a person of ordinary skill in the relevant art previous to the priority date.

In the case of *Kendek Industry Sdn Bhd v. Ecotherm (Tft) Sdn Bhd* [2010] 10 CLJ 219, the learned Judge, by relying on several English decisions, observed that it is necessary to identify persons skilled in the art in a given case so that the court may determine what the state of knowledge of such persons are at the relevant time and then adopt the mantle of the notional skilled man before proceeding to construe the claim in the light of that knowledge. Argument alone is insufficient. The Court would require competent witnesses to come and speak for the matter with proof of recollection.

Common knowledge need not extend to all those engaged in the art concerned, but it certainly includes what is known to most of them

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

The Court in Malaysia follows the principle expressed by Lord Reid said in *Technograph v Mills & Rockley* [1972] RPC 346 at page 355:

"In dealing with obviousness, unlike novelty, it is permissible to make a 'mosaic' out of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capacity."

As such it is permissible to combine together two or more prior art reference but only where such combination would have been obvious to a person having the ordinary skill in the art at the effective priority date.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

In Malaysia, it is possible to combine two or more references only when such combination is the common general knowledge of the ordinary skilled person. In such event, the closeness of the technical field to what is being claimed is likely to be an important factor.

The problem the inventor was trying to solve may be relevant, but greater importance will be given to problems specifically referred to in the patent specification, in particular, the court will give greater importance to what the patent states and to the evidence adduced in court.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

In light of the discussion above, the logical conclusion will be that the greater the number of references that have to be combined to support a finding of lack of inventive step, the stronger the indication that the invention involves an inventive step.

13. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

Technical problem will be one of the indications of inventive step. Where the technical problem is set out in the specification of the patent, it will assist the identification of inventive concept.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem does not necessarily have to be disclosed or identified in the specification.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects are factors to be considered in assessing whether there is an inventive step. If the advantageous effects are the solution/improvement to the technical problem of the prior art can be shown to be something which is not obvious to the person skilled in the art, it would help satisfy the requirement of inventive steps but if the advantageous effects arise from obvious modification, it is not inventive. If the invention is obvious, having an advantageous effect will not make it inventive.

17. Must the advantageous effects be disclosed in the as-filed specification?

Yes, the advantageous effects should be disclosed in the patent application as required in Regulation 12(1)(c) of the Patents Regulations 1986.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes.

19. How “real” must the advantageous effects be? Are paper or hypothetical examples sufficient?

Paper or hypothetical examples that are be clear to the skilled person reading the prior art are sufficient during examination, but if challenge in court, such examples may require verification it is critical to the requirement of inventiveness.

20. Do the answers to any of the questions above differ during examination versus during litigation?

During examination the advantageous effects can be completely hypothetical. In litigation, evidence as to advantageous effects is likely to be required and thus presented.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Teaching away is another factor to be considered in relation to the existence of an inventive step. The teaching away need not be explicit but then evidence as to how a skilled person would read the document may be required to give weight to the existence for inventive step.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is one of the factors of the consideration of inventive step but the weight given will not be any more weight than other factors of inventive step.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No, but in litigation, evidence as to how a skilled person would read the teaching of a prior art reference is likely to be required.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

- commercial success of the invention;
- workshop variations
- failure of others to overcome the technical difficulty addressed by the patent;

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?
If yes, please describe these issues, tests, or factors.

- Why was it not done before?
- Fulfilling a long-felt need
- Advantages of the invention

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

The question to be asked in considering the objection of obviousness to the validity of a patent has been formulated in a number of ways:

(1) Was it for practical purposes obvious to a skilled worker, in the field concerned, in the state of knowledge existing at the date of the patent to be found in the literature then available to him, that he would or should make the invention the subject of the claim concerned? (*Killick v Pye Ltd* [1958] RPC 366 at 377, CA);

(2) Would the man skilled in the art be alerted to the possibilities? (*Johns-Manville Corprsq's Patent* [1967] RPC 479 at 494, CA);

- (3) Would the person versed in the art assess the likelihood of success as sufficient to warrant actual trial?

It is possible to find the question posed as either 'was it obvious that a skilled man should' or 'was it obvious that a skilled man could' 'make the invention?' and the correct question may depend upon whether the invention lies in ascertaining the problem to be solved or in the way in which the problem is solved (*Hallen Co v Brabantia (UK) Ltd* [1989] RPC 307 at 326; affd [1991] RPC 195 at 212, CA).

There are four steps which must be taken by the court in answering this question of fact:

- (1) to identify the inventive concept embodied in the patent in suit;
- (2) to ascertain what was, at the priority date, the prior art in question and to impute this to the person having ordinary skill in the art;
- (3) to identify what, if any, difference exists between the matter cited as being 'prior art' and the alleged invention; and
- (4) whether, viewed without any knowledge of the alleged invention (*British Westinghouse Electric and Manufacturing Co v Braulik* (1910) 27 RPC 209 at 230, CA), those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention (*Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 at 72, CA).

29. Does such test differ during examination versus during litigation?

No.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

The approach taken is the same but the result arrived at may be different and any divergence is normally due to the resources available to examiners and the resources that the litigants avail themselves to in a litigation. Examiners do not have the benefit of the research that are usually conducted for a litigation and also the arguments presented on both sides.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

There is no divergence in approach, only a divergence in effectiveness.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

There is only a single patent granting authority in Malaysia.

33. If yes, is this problematic?

Not applicable.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes, harmonization of inventive step is desirable as it provides the universally acceptable minimum standard. Countries signatory to the Paris Convention should apply the same standard according to the same approach so that there would be no confusion in registration in different countries. As such, if an invention is patentable in Malaysia, there should be no problem obtaining a patent for the same invention in Europe or United States.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

Yes.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

An invention shall involve an inventive step if, having regard to the prior art at the priority date, the invention as a whole is not obvious to a person skilled in the art.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

It is proposed that the following approach should be applied by the Examiners and Courts:

- (1) identify the prior art at the priority date;
- (2) identify the "person skilled in the art" and the level of common general knowledge of that person;
- (3) identify the similarities and differences between the prior art and the claimed invention to determine whether the differences is obvious to the person skilled in the art.